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EXAMINER

HALE, GLORIA M

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STACIA LINSKY and ELAINA BANKS

Appeal 2009-004623
Application 10/625,716
Technology Center 3700

Decided: December 8, 2009

Before LORA M. GREEN, MELANIE L. McCOLLUM, and JEFFREY N.
FREDMAN, *Administrative Patent Judges*.

McCOLLUM, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 involving claims to a breast self-examination apparatus and a method of breast self-examination. The Examiner has rejected the claims as anticipated or obvious. We have jurisdiction under 35 U.S.C. § 6(b). We affirm-in-part.

STATEMENT OF THE CASE

Claims 1-5, 7-14, 16-23, and 25-29 are on appeal (App. Br. 2). Claims 6, 15, and 24 are also pending but have been indicated to be allowable (Final Rej. 6). We will focus on claims 1, 11, 19-21, and 28, which read as follows:

1. A breast self-examination apparatus, comprising:
a form-fitting garment comprising armpit areas; and,
at least one examination pattern disposed on said garment.
11. A breast self-examination apparatus, comprising:
a form-fitting garment;
at least one breast examination pattern disposed on said garment; and,
at least one armpit examination pattern disposed on said garment.
19. A breast self-examination apparatus, comprising:
a form-fitting t-shirt;
at least one examination pattern disposed on said t-shirt; and,
at least one marking instrument for marking or designating areas of
suspected abnormalities directly on said t-shirt.
20. The apparatus of Claim 19, wherein said t-shirt is fabricated from a
thin material.
21. The apparatus of Claim 19, wherein said t-shirt comprises a low-
coefficient of friction to facilitate hand and finger movement over said at
least one examination pattern.
28. A method of breast self-examination, comprising the steps of:
 - a. obtaining a breast self-examination apparatus, comprising:
a form-fitting garment; and,
at least one examination pattern disposed on said garment; and
 - b. putting on said garment;
 - c. aligning said at least one examination pattern over a breast; and,
 - d. examining and palpating the breast from the outside of said
garment via guiding at least one finger over said at least one
examination pattern.

Claims 1-5, 8, and 28 stand rejected under 35 U.S.C. § 102(b) as anticipated by Fingleson (US 5,479,661, issued Jan. 2, 1996) (Ans. 4).

Claims 7, 11-14, and 16 stand rejected under 35 U.S.C. § 103(a) as obvious over Fingleson in view of Morrison (US 4,873,982, issued Oct. 17, 1989) (Ans. 7).

Claims 9, 10, 19-23, 25-27, and 29 stand rejected under 35 U.S.C. § 103(a) as obvious over Fingleson in view of Rusin (US 6,412,491 B1, issued Jul. 2, 2002) (Ans. 9).

Claims 17 and 18 stand rejected under 35 U.S.C. § 103(a) as obvious over Fingleson in view of Morrison and Rusin (Ans. 9).

ANTICIPATION

The Examiner finds that Fingleson “discloses a breast self-examination apparatus, garment 10, including a form-fitting garment . . . with at least one examination pattern 38,40 . . . disposed on the garment” (Ans. 5). The Examiner also finds that Fingleson “discloses the method of breast self-examination including obtaining the breast examination form-fitting garment 10 with the pattern 38,40; putting on the garment, aligning the garment pattern with the breast and examining the breasts as” in claim 28 (*id.* at 6).

Appellants argue that Fingleson “fails to teach ‘armpit areas’” (App. Br. 7). Appellants also argue that Fingleson “fails to teach the step of examining the breast from the outside of the garment” (*id.* at 8).

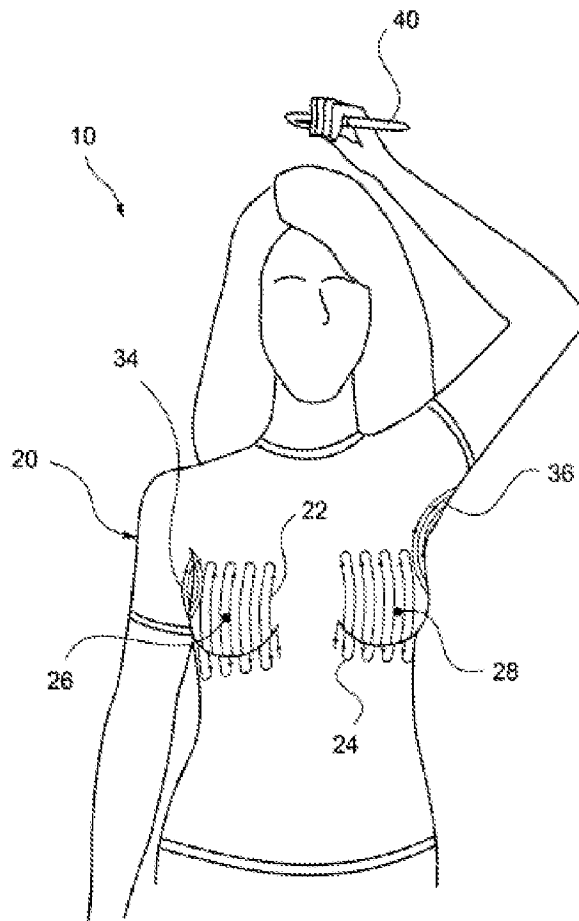
Issues

Did the Examiner err in finding that Fingleson discloses a garment comprising armpit areas?

Did the Examiner err in finding that Fingleson discloses examining and palpating the breast from the outside of the garment?

Findings of Fact

1. The Specification discloses a shirt-like garment having breast self-examination patterns thereon (Spec. 6: 14-16).
2. The Specification also discloses that a user of the garment conducts “a breast self-examination by palpating her breasts from the outside of the garment, as opposed to directly feeling or contacting her bare breasts” (*id.* at 6: 21 to 7: 2).
3. Specification Figure 5 is reproduced below:



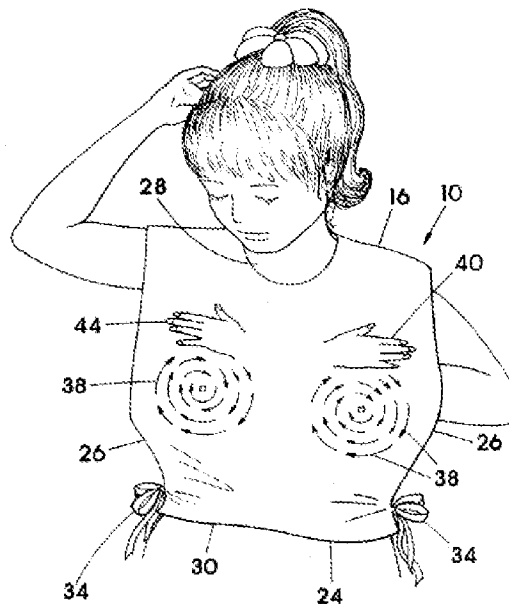
Specification Figure 5 “is a perspective view of an apparatus for facilitating breast self-examinations . . . , shown in use” (*id.* at 12: 5-8).

4. The Specification discloses that “spiral or circular-like examination patterns . . . are disposed or printed on respective armpit areas 34 and 36 of garment 20” (*id.* at 15: 4-6).

5. Fingleson discloses “an upper body garment having open sides with ties, with the front panel of the garment printed with written and graphic instructions for breast self-examination” (Fingleson, col. 2, ll. 2-6).

6. Fingleson also discloses that the “sides of the garment are left open so the woman can easily reach through to examine her breasts” (*id.* at col. 2, ll. 23-26).

7. Fingleson Figure 8 is reproduced below:



Fingleson Figure 8 depicts “the instructional garment in use being worn by a woman conducting a self-examination of her breasts” (*id.* at col. 2, ll. 56-57).

8. Fingleson discloses that the “wearer passes her hand through the side openings of garment 10 under front panel 12 to complete the procedure” (*id.* at col. 4, ll. 18-20).

Principles of Law

“It is axiomatic that, in proceedings before the PTO, claims in an application are to be given their broadest reasonable interpretation consistent with the specification.” *In re Sneed*, 710 F.2d 1544, 1548 (Fed. Cir. 1983).

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros., Inc. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987).

Analysis

Claim 1 recites “a form-fitting garment comprising armpit areas.” Consistent with the ordinary meaning of the term “armpit areas” and how it is used in the Specification (Findings of Fact (FF) 3-4), we interpret claim 1 to require that the garment include areas that cover a person’s armpits.

Fingleson discloses “an upper body garment having open sides with ties, with the front panel of the garment printed with written and graphic instructions for breast self-examination” (FF 5). We agree with Appellants that the Examiner has not set forth a *prima facie* case that Fingleson’s garment includes armpit areas.

The Examiner finds that “the open area under the arms, in addition to the garment fabric area adjacent to the arm areas and thereabout the side of the garment that would inherently fold around and under the wearer’s arms

when worn, is the ‘armpit area’ as broadly interpreted” (Ans. 5). In particular, the Examiner finds:

Fing[le]son . . . covers “Armpit areas” as broadly claimed since the side portions of the Fing[le]son et al garment, along the side edges would cover the outer edges of one’s armpits at the front and rear shoulder areas. The fabric about one’s arm would fold over in use under the underarm and therefore be in an “armpit area”. . . . Appellant[s’] drawings also show the armpit areas as extending outwardly from under the arms to cover a wearer’s lymph gland areas.

(*Id.* at 11.)

We do not agree. First, the Examiner has set forth no support for her assumption that “the garment fabric area adjacent to the arm areas and thereabout the side of the garment . . . would inherently fold around and under the wearer’s arms” (Ans. 5). In addition, although the side edges of Fingleson’s garment would, from the front and rear directions, cover the outer edges of the wearer’s armpits (*see* FF 7), we do not agree that one of ordinary skill in the art would refer to these regions as the armpit areas of the garment. In addition, although Specification Figure 5 may depict the circular pattern as extending beyond the armpit regions (FF 3-4), we do not agree that Appellants’ drawings show the armpit areas as extending beyond the areas of a person’s body that would normally be considered the armpits.

Claim 28 recites “examining and palpating the breast from the outside of said garment.” Consistent with the ordinary meaning of the phrase “the outside of said garment” and how it is used in the Specification (FF 2), we interpret claim 28 to require examining and palpating the breast from the outside of the garment, “as opposed to directly feeling or contacting [the] bare breast” (*id.*). We do not agree that the Examiner is being reasonable in

instead interpreting “the term ‘outside of the garment’ . . . to be away from the garment material layer or outside of the garment material” (Ans. 6).

Instead of examining and palpating the breast from the outside of the garment, Fingleson discloses that the “wearer passes her hand through the side openings of garment 10 under front panel 12 to complete the procedure” (FF 8; *see also* FF 6-7). Thus, we agree with Appellants that the Examiner has not set forth a *prima facie* case that Fingleson discloses examining and palpating the breast from the outside of the garment.

Conclusion

The Examiner erred in finding that Fingleson discloses a garment comprising armpit areas. We therefore reverse the anticipation rejection of claim 1 and of claims 2-5 and 8, which depend from claim 1.

The Examiner also erred in finding that Fingleson discloses examining and palpating the breast from the outside of the garment. We therefore reverse the anticipation rejection of claim 28.

OBVIOUSNESS – FINGLESON AND MORRISON

The Examiner relies on Fingleson for disclosing “the invention substantially as claimed” (Ans. 7). However, the Examiner states that Fingleson “does not specifically disclose the garment as extending directly over the underarm area” (*id.*).

The Examiner relies on Morrison for disclosing “a breast examination garment that extends to an underarm or side area of the wearer” (*id.*). The Examiner finds that Morrison “discloses that the garment is adapted for use in other areas of the body where the detection of lumps is desired (such as the underarm area)” (*id.* at 7-8).

The Examiner concludes that it would have been obvious “to construct the [Fingleson] garment to extend under the arm areas by including the side portions as seen in Morrison and to mark those areas in a similar fashion as the Fing[le]son front surface as suggested by Morrison . . . in order to effectively examine the wearer for breast cancer” (*id.* at 8).

Appellants argue that neither Fingleson nor Morrison discloses “an examination pattern disposed on an armpit area of an examination garment” (App. Br. 9).

Issue

Did the Examiner err in finding that Fingleson and Morrison disclose or suggest a breast self-examination apparatus comprising a garment having at least one armpit examination pattern disposed thereon?

Findings of Fact

9. Morrison discloses “a garment which is useful for examining a surface for lumps or irregularities comprising two contacting plies” (Morrison, col. 1, ll. 63-65).

10. Specifically, Morrison discloses a garment “adapted to fit around the upper torso and over the breast area of an individual” (*id.* at col. 2, ll. 1-2).

11. Morrison also discloses that the garments “may be specially adapted for use with other parts of the body” (*id.* at col. 4, ll. 18-21).

12. In addition, Morrison discloses that, “if the person wears the garment while being examined, and the doctor notes an area that the patient should check periodically, the garment can be marked where the patient is to

perform the specific periodic self-examinations at home” (*id.* at col. 4, ll. 12-18).

Principles of Law

“In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness. Only if that burden is met, does the burden of coming forward with evidence or argument shift to the applicant.” *In re Rijckaert*, 9 F.3d 1531, 1532 (Fed. Cir. 1993) (citation omitted). “It is fundamental that rejections under 35 U.S.C. § 103 must be based on evidence comprehended by the language of that section.” *In re Grasselli*, 713 F.2d 731, 739 (Fed. Cir. 1983).

Analysis

Claim 11, as well as claim 7, recites a breast self-examination apparatus comprising a garment having at least one armpit examination pattern disposed thereon. We agree with Appellants that the Examiner has not set forth a *prima facie* case that Fingleson and Morrison teach or suggest a garment having at least one armpit examination pattern disposed thereon.

As noted by the Examiner, Morrison discloses that its garment “may be specially adapted for use with other parts of the body” (FF 11). In addition, Morrison discloses that “the garment can be marked where the patient is to perform . . . specific periodic self-examinations at home” (FF 12). However, the Examiner has not pointed to an adequate teaching or suggestion of a garment having at least one armpit examination pattern disposed thereon.

The Examiner does states that “one of ordinary skill in the art with experience of breast examination and the well known charts used in such

examination by the public and health care workers would know to extend the examination to the underarm lymph gland areas” (Ans. 18). However, the Examiner has not provided evidence that it was known in the art at the time of the present invention to examine the armpit area or that armpit examination patterns were known in the art.

Conclusion

The Examiner erred in finding that Fingleson and Morrison disclose or suggest a breast self-examination apparatus comprising a garment having at least one armpit examination pattern disposed thereon. We therefore reverse the obviousness rejection of claims 7 and 11 and of claims 12-14 and 16, which depend from claim 11.

OBVIOUSNESS – FINGLESON AND RUSIN

The Examiner relies on Fingleson for disclosing “the invention substantially as claimed,” but states that Fingleson “does not specifically disclose the marker pens as claimed” (Ans. 9). The Examiner relies on Rusin for disclosing “a breast examination device with a sheet material and a marker pen . . . , in order to mark areas on the sheet 101 for further examination or areas of further concern” (*id.*). The Examiner concludes that it would have been obvious “to modify the garment of Fing[le]son to include [a] marking pen to mark areas on the garment over the sites on the wearer where further examination or areas of interest are on the wearer” (*id.*).

With respect to claims 9, 10, and 29, Appellants argue that “Rusin fails to remedy the deficiencies of Fingleson *et al.*, i.e. the failure of Fingleson *et al.* to teach armpit areas examination from outside the garment” (App. Br. 11).

With respect to claim 19, Appellants argue that Fingleson and Rusin fail to teach a form-fitting t-shirt (*id.* at 11-12).

With respect to claims 20 and 21, Appellants argue that Fingleson and Rusin “further fail to teach the thin material or the low coefficient of friction for facilitating movement of the user’s hand and fingers over an examination pattern” (*id.* at 12).

Issues

Did the Examiner err in finding that Fingleson and Rusin teach or suggest: (1) a garment including armpit areas, as required by claim 9; (2) examining and palpating the breast from the outside of a garment via guiding at least one finger over an examination pattern, as required by claim 29; (3) a form-fitting t-shirt, as required by claim 19; (4) a t-shirt fabricated from a thin material, as required by claim 20; and (5) a t-shirt comprising a low-coefficient of friction, as required by claim 21?

Findings of Fact

13. The Specification states that the “garment 20 is preferably manufactured in a variety of tight or form-fitting sizes” (Spec. 13: 14-15).

14. The term “form-fitting” is defined as “conforming to the outline of the body : fitting snugly.” Merriam-Webster Online Dictionary, <<http://mw1.merriam-webster.com/dictionary/formfitting>>, Oct. 1, 2007 (of record).

15. The term “shirt” is defined as “a garment for the upper part of the body.” Merriam-Webster Online Dictionary, <<http://merriam-webster.com/dictionary/shirt>>, Nov. 25, 2009.

16. The term “T-shirt” is defined as “a collarless short-sleeved or sleeveless usually cotton undershirt” or “an outer shirt of similar design.” Merriam-Webster Online Dictionary, <<http://merriam-webster.com/dictionary/t-shirt>>, Nov. 25, 2009.

17. Fingleson discloses that its garment “is preferably manufactured of a soft, flexible woven fabric 18 which is machine washable, but . . . can also be made of a plastic or paper material which may or may not be disposable” (Fingleson, col. 3, ll. 1-4).

18. Rusin discloses “an examination device which can be used to facilitate physical examination of the breast,” including “a drape which can be applied to the body,” the drape having “a smooth ‘reduced friction’ surface on one side and a complimentary surface that clings to exposed skin” (Rusin, col. 2, ll. 13-20).

19. Rusin also discloses that the device “may also include a marker 150 attachable to the device 101 for identification of a location of interest on the portion of the human body under examination” (*id.* at col. 3, ll. 24-28).

20. In addition, Rusin discloses:

[T]he examiner (e.g. a physician conducting a tactile breast examination on a patient or a patient conducting self breast examination) places a device 101 over the portion of the human body, such as a breast, for examination. Next the examiner then slides the examining hand across the top surface 110 of the device 101. . . .

When a lump of interest is found on the patient’s body it is identified through tactile examination, and the examiner may mark the point of interest on the device 101 with marker 150.

(*Id.* at col. 3, ll. 39-52.)

Principles of Law

Obviousness analysis “need not seek out precise teachings directed to the specific subject matter of the challenged claim.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007). Instead, it proper to “take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *Id.* “A person of ordinary skill is also a person of ordinary creativity, not an automaton.” *Id.* at 421.

“[T]erms [that] merely set forth the intended use for, or a property inherent in, an otherwise old composition . . . do not differentiate the claimed composition from those known to the prior art.” *In re Pearson*, 494 F.2d 1399, 1403 (CCPA 1974).

Analysis

Claim 19 recites “a form-fitting t-shirt.” We agree with Appellants that the term “form-fitting” requires that the t-shirt “conform[] to the outline of the body : fit[] snugly” (FF 14; App. Br. 7, fn. 1). However, as pointed out by the Examiner, the “form-fitting function would depend greatly on the size of the wearer and not just on the type of material used to construct the garment” (Ans. 10). Thus, we interpret claim 19 to require a t-shirt that is capable, on a particular wearer, of being form-fitting.

The term “t-shirt” is defined as “a collarless short-sleeved or sleeveless usually cotton undershirt” or “an outer shirt of similar design” (FF 16). In addition, the term “shirt” is defined as “a garment for the upper part of the body” (FF 15). Therefore, giving these terms their broadest reasonable interpretation, we interpret a t-shirt to include a collarless, sleeveless, garment for the upper part of the body.

Fingleson discloses a collarless, sleeveless, upper body garment (FF 5 & 7). Appellants have not adequately shown why this garment would not be considered a t-shirt, nor have they adequately explained why this garment is not capable of being worn such that it is form-fitting.

With regard to claims 20 and 21, Fingleson discloses that its garment “is preferably manufactured of a soft, flexible woven fabric 18 which is machine washable, but . . . can also be made of a plastic or paper material which may or may not be disposable” (FF 17). We agree with Appellants that the Examiner has not pointed to specific teachings indicating that Fingleson’s garment is fabricated from a thin material or that it comprises a low-coefficient of friction to facilitate hand and finger movement over an examination pattern. However, given the broad disclosure in Fingleson of woven fabric, as well as plastic and paper, we agree with the Examiner that it would have been obvious to fabricate Fingleson’s garment from a thin material and such that it comprises a low-coefficient of friction.

With regard to claim 9, which depends from claim 1, the Examiner has not set forth a prima facie case that Fingleson discloses a garment comprising armpit areas for the reasons discussed above. In addition, the Examiner has not set forth a prima facie case that such a garment would have been obvious in view of Rusin.

With regard to claim 29, which depends from claim 28, the Examiner has not set forth a prima facie case that Fingleson discloses examining and palpating the breast from the outside of a garment for the reasons discussed above. In addition, the Examiner has not set forth a prima facie case that this step would have been obvious in view of Rusin. In this regard, we note

that Rusin discloses that “the examiner . . . slides the examining hand across the top surface 110 of the device 101” (FF 20). However, the Examiner only relies on Rusin for the marker element (Ans. 17).

Conclusion

Appellants have not shown that the Examiner erred in finding that Fingleson and Rusin teach or suggest a form-fitting t-shirt. We therefore affirm the obviousness rejection of claim 19. Claims 22, 23, and 25-27 have not been argued separately and therefore fall with claim 19. 37 C.F.R. § 41.37(c)(1)(vii).

Additionally, Appellants have not shown that the Examiner erred in finding that Fingleson and Rusin teach or suggest a t-shirt fabricated from a thin material or a t-shirt comprising a low-coefficient of friction. We therefore affirm the obviousness rejection of claims 20 and 21.

The Examiner did, however, err in finding that Fingleson and Rusin teach or suggest a garment including armpit areas and examining and palpating the breast from the outside of a garment via guiding at least one finger over an examination pattern. We therefore reverse the obviousness rejection of claims 9 and 29 and of claim 10, which depends from claim 9.

OBVIOUSNESS – FINGLESON, MORRISON, AND RUSIN

Claims 17 and 18 depend from claim 11. As discussed above, the Examiner erred in finding that Fingleson and Morrison disclose or suggest a breast self-examination apparatus comprising a garment having at least one armpit examination pattern disposed thereon. In addition, the Examiner has not set forth a prima facie case that Rusin overcomes this deficiency. We therefore reverse the obviousness rejection of claims 17 and 18.

SUMMARY

We affirm the obviousness rejection of claims 19-23 and 25-27. However, we reverse the anticipation rejection of claims 1-5, 8, and 28 and the obviousness rejections of claims 7, 9-14, 16-18, and 29.

TIME PERIOD FOR RESPONSE

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED-IN-PART

cdc

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